

Application No. 09/675,743  
Amendment Dated November 17, 2003  
Reply to Office Action of September 3, 2003

**REMARKS/ARGUMENTS**

By this Amendment, claims 1, 12, 16 and 19 are amended. Claims 21-27 and 29 have been withdrawn from consideration pursuant to a restriction requirement. Claims 1-4, 12-16 and 19-29 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The Examiner's courtesy in granting an interview to Applicants' representative on October 30, 2003 is gratefully acknowledged. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

Support for the foregoing amendments is apparent in the original specification, particularly in original claim 12 and page 10, line 9 to page 11, line 5.

Claims 1, 2, 4, 16 and 28 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Fenton. This rejection is respectfully traversed.

The Office Action identifies spring H of Fenton as the dampener of the rejected claims. However, as agreed at the interview, spring H does not meet the limitation of the rejected claims, wherein the dampener is adapted to "dampen displacement of the second shaft end away from the one tubular outer end of the frame in response to compression of the bias member from a pre-impact position to a compressed position." Thus, the Office Action fails to make a *prima facie* case of anticipation in that it fails to show how Fenton meets each and every limitation of the claimed invention.

Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1, 2, 4, 16 and 28 are respectfully requested.

Claims 3 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Fenton in view of Noel. This rejection is respectfully traversed.

Fenton fails to identically disclose all the limitations of the claimed invention for at least the reasons noted above. Regardless of whether the Final Rejection is correct that one of ordinary skill in the art would have found it obvious to combine with the teachings of Fenton Noel's alleged teachings of a compressible cap coupled with a shaft end, the proposed combination of reference teachings still fails to disclose or suggest all the limitations of the claimed invention. For example, Noel fails to remedy the failure of Fenton to disclose the dampener limitation of the claims.

Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 3 and 15 are respectfully requested.

Claims 12-14 and 19-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Fenton in view of Johnsen. This rejection is respectfully traversed.

At the interview, it was agreed that the piston subassembly 71 could dampen the rebound of bias members 30 and 66 from a compressed position to a pre-impact position, contrary to Applicants' previous arguments. Nonetheless, neither Johnsen nor Fenton teaches the provision of a dampener adapted to dampen expansion of the bias member from the compressed position to the pre-impact position more than compression of the bias member from the pre-impact position

to the compressed position, as recited in claims 19-20 (and base claims 1 and 16). Furthermore, neither Johnsen nor Fenton teaches an air flow damper adapted to assume two different fluid flow regulating orientations: (1) a non-fluid flow obstructing orientation when the second shaft end of the shaft is displaced toward the frame; and (2) a fluid flow obstructing position when the biasing member displaces the second shaft end of the shaft away from the frame so as to slow displacement of the second shaft end of the shaft away from the frame, as recited in base claim 12. The symmetrical shapes of the washer in Johnsen and head D in Fenton suggest that they would provide substantially the same dampening effect (if any, in the case of Fenton, which does not disclose that head D has a dampening effect) in either direction of movement.

One of ordinary skill in the art at the time of the invention would have lacked motivation to modify the references to reach the claimed invention with a reasonable expectation of success. Firstly, Fenton does not teach that head D provides any dampening effect, but rather states that head D is "free to move" within the hollow handlebar A. Fenton at page 1, line 93.

Secondly, Johnsen teaches that the importance of the dampening effect provided by washer 76 is against compression, not against expansion. As the bike seat is driven downward to compress the mounting post assembly, "the compression of air beneath washer 76 cushions the impactive forces applied to the seat in addition to the spring reactive forces due to coils 30, 66." Johnsen at column 5, lines 62-66. One of ordinary skill in the art would not have been reasonably motivated by these teachings of Johnsen to provide a dampener with a diminished capacity to assist a bias member in resisting compression. There is nothing obvious about combining references for what they do not teach. See, e.g., *In re Gordon et al.*, 733 F.2d 900,

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221 USPQ 1125 (Fed. Cir. 1984) (The court reversed an obviousness rejection based on a combination which included a prior art filter-separator which was physically inverted in the combination, thereby eradicating the function taught by the prior art).

Moreover, Johnsen at column 5, lines 51-57, teaches the advantages of using a washer to "offer additional lateral stability to the bicycle seat post assembly." This could only be possible with a washer of sufficient resiliency that it would not readily deform to adopt the two air-flow damper configurations of claims 19-20.

Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 12-14 and 19-20 are respectfully requested.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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